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| 09/645,279      | 08/24/2000  | Caren H Baker        | EMPIR-020PUS        | 3823             |

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EXAMINER

STEELMAN, MARY J

ART UNIT

PAPER NUMBER

2122

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/645,279

Applicant(s)

BAKER ET AL.

Examiner

Mary J. Steelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/11/00, 09/23/02, 11/26/02, 12/23/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claims 1-19 are pending.

#### *Drawings*

2. This application, filed under former 37 CFR 1.60, lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings. In unusual circumstances, the formal drawings from the abandoned parent application may be transferred by the grant of a petition under 37 CFR 1.182.

#### *Specification*

3. The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### *Claim Objections*

4. Claim 19 is objected to because of the following informalities: Recites "...1 further...", should be --1 further--. Add a space between 1 and f. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

#### 7.35.01 Trademark or Trade Name as a Limitation in the Claim

Claim 13 contains the trademark/trade name JAVA. Where a trademark or trade name

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is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a byte code component and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 9, 12-15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,473,794 to Guheen et al.

Per claim 1:

-receiving, by a service provider, at least one software component from a customer; (Guheen: Col. 175, lines 56-59, "Data relating to needs of a user may also be received for the purpose of outputting a recommendation of the products and services based on the inputted needs.")

-providing, by said service provider, test code for testing said at least one software component; (Guheen: Col. 271, lines 5-27, "Automatically compiles finished code to test technical correctness...")

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-testing with said test code said at lest one software component; (Guheen: Fig. 97, #3606 and col. 270, lines 54-55, "...in operation 3606, the operability of the system applications are tested.")

-monitoring, by said service provider, results of said testing; (Guheen: Col. 268, lines 65-67, "Monitors production web site performance and traffic...")

-providing, by said service provider, the results of said testing to said customer. (Guheen: Col. 269, lines 1-3, "The management and operations component of the present invention may monitor production web site performance and traffic.")

Per claims 2 - 4: (Guheen: Col. 193, line 62 – col. 194, line 10, and col. 178, line 35, "...pay for services...", and col. 268, lines 54-60, "...bill for that usage...a user would be billed for belonging to a site requiring a monthly fee for viewing.")

Per claim 5: (Guheen: Col. 185, lines 10-12, "The present invention provides a system and method for conducting commerce via an electronic means, such as a computer network.")

Per claims 6 & 7: (Guheen: Col. 190, lines 14-18, "...contact millions of potential customers is to use the global Internet...using the well defined TCP/IP protocol.")

Per claim 9: (Guheen: Col. 131, line 18, "...prepare for regression testing...", and col. 256, lines 28-31, "Load Balancing Spreads tasks among application servers using an intelligent load balance scheme" and col. 271, lines 1-2, "local and remote hyperlinks may be automatically tested" and line 10, "test technical correctness" and lines 61-63, "Simulates multiple users on web site" Also, col. 272, lines 2-4, Enables programmatic control of load generation. Allows tests to be scheduled and load to be varied over time.")

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Per claim 12: (Guheen: Col. 2, lines 9-15 and col. 7, lines 65-67, "...pictorial representation of an existing network framework is displayed...")

Per claim 13: (Guheen: Col. 15, lines 14-15 and col. 19, bottom of page, "JavaBeans Development Kit")

Per claim 14: (Guheen, Col. 27, lines 35-36, "Provides ability to preview, test and change applications before production stage.")

Per claim 15: (Guheen: Co. 271, lines 61-62, "WEB SITE TESTING TOOLS...")

Per claim 19: (Guheen: Col. 161, lines 14-15, "Archiving can be used to move information to of from distributed and centralized sites.")

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 10, 11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,473,794 to Guheen et al., in view of U.S. Patent 5,371,883 to Gross et al.

Guheen disclosed a system for testing components of web based frameworks. Guheen failed to disclose details on receiving directions regarding the type of testing to be done, how to process results from testing, the test format, and determining the input / output parameters. However, Gross provided more details regarding testing in a networked environment in his invention.

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Per claim 8: (Gross: Col. 4, lines 47-52, "...user specifies...values...applicable..." and col. 5, lines 4-22.)

Per claim 10: (Gross: Col. 6, lines 34-38, "...user can produce many reports..." )

Per claim 11: (Gross: Col. 3, lines 23-26, "...the results are correct..." )

Per claim 16: (Gross: Fig. 1 and Col. 7, lines 34-38, "...limited only by the number of machines attached..." and lines 53-60.)

Per claim 17: (Gross: Col. 3, lines 7-17, "...creation and storage of Test Case...Control Machine...contains...test cases and their expected results..." )

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to have modified Guheen's invention to test component of a web based framework by including Gross' invention of testing in a distributed environment, because although Guheen showed a linked host and target, he failed to show details of testing / reporting directions, a plurality of containers for testing and determining inputs / outputs which are used for (col. 1, lines 26-30) adequately testing...each of the modules, integrating the modules...testing the subsystem and...the entire system. Furthermore, (col. 2, lines 5-7) the "centralized database of test case information...used in planning, tracking, and as input to the control process" provides an improved method of testing in a distributed environment.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,473,794 to Guheen et al., in view of U.S. Patent 5841670 to Swoboda.

Guheen disclosed a system for testing components of web based frameworks. Guheen failed to disclose using a graphical user interface to test the components. However Swoboda

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disclosed (Fig. 45, and col. 8, lines 20-26) software emulation using the user interface to test components.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to have modified Guheen's invention to test component of a web based framework by including emulation using a graphical user interface because (col. 1, lines 64-67) "designed-in testability is needed, so that the finished product is still both controllable and observable during test and debug.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (703) 305-4564. The examiner can normally be reached Monday through Thursday, from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 308-4789.

The fax phone numbers are (703) 746-7240 for regular communications and (703) 746-7239 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MS



05/02/2003



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